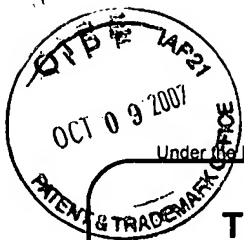


10-10-07

IAF/JFW



PTO/SB/21 (10-07)

Approved for use through 10/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Form + 6

| | |
|------------------------|------------|
| Application Number | 10/663,498 |
| Filing Date | 09-16-2003 |
| First Named Inventor | Anderson |
| Art Unit | 3611 |
| Examiner Name | Silbermann |
| Attorney Docket Number | 453.1 |

ENCLOSURES (Check all that apply)

| | | |
|--|--|---|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): |
| Remarks REPLY BRIEF Express Mail EV 915329804 US | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|---|----------|--------|
| Firm Name | | | |
| Signature | | | |
| Printed name | James Scott Anderson (Applicant / Inventor) | | |
| Date | Tuesday, October 9, 2007 | Reg. No. | 48,563 |

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

| | | | |
|-----------------------|----------------------|------|---------------------|
| Signature | | | |
| Typed or printed name | James Scott Anderson | Date | Tues., Oct. 9, 2007 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/663,498
Applicant / Appellant : **Anderson, James Scott**
Filing Date : **September 16, 2003**
Title : **ERASABLE TRAY LABELS**
Art Unit : 3611
Examiner : **Silbermann, Joanne**
Confirmation No. : 2443
Docket No. : 453.1

Mail Stop Appeal Brief – Patents
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Pursuant to MPEP 1208 and 37 C.F.R. § 41.41(a), the Applicant/Appellant hereby submits this Reply Brief in response to the Examiner's Answer dated August 7, 2007.

The Examiner's final rejection must be reversed because the cited references do no teach or suggest all the elements of the claimed invention. First, the "writing surface" recited in claims 1 and 16 cannot be obvious in light of a single reference disclosing no writing surface whatsoever. Second, the "semi-rigid core [with] a slot" recited in claims 34 and 43 cannot be obvious in light of the hollow space inside a plastic medallion. Because the references do not teach or suggest all the features recited in the claims, the rejection fails to set forth a *prima facie* case of obviousness and the rejection should be reversed, with instructions to allow all the pending claims in the application.

**I. THE “WRITING SURFACE” RECITED IN CLAIMS 1 AND 16
CANNOT BE OBVIOUS IN LIGHT OF A SINGLE REFERENCE
DISCLOSING NO WRITING SURFACE WHATSOEVER.**

A single reference¹ that does not teach or suggest a “writing surface” as claimed does not satisfy the examiner’s initial burden of establishing a *prima facie* case of obviousness. Downing does not teach or suggest a writing surface of any kind.

The rejection of independent claims 1 and 16 rests entirely on the Examiner’s assertion that the disclosure in a single reference of an apparatus having *any surface* with indicia thereon (e.g., Downing) teaches or suggests a “writing surface” as recited in claims 1 and 16.² Applying basic logic, the disclosure of an apparatus having *any surface* cannot render obvious the pending claims reciting “a generally planar writing surface for receiving temporary and permanent indicia” and other patentable features.

The surface in Downing should not be considered a writing surface simply because it includes permanent indicia. Many surfaces include permanent indicia, from computer keyboards to telephones and automobiles. The presence of permanent indicia does not make every such surface a “writing surface” – *especially the surface in Downing*. Downing discloses a detachable cushion for the armrest of a chair – plainly not a suitable location for writing temporary indicia because it would be quickly smudged or erased during normal use. No person reading Downing would conclude that a cushion on the armrest of a chair is a writing surface.

¹ *Downing* is not combined with any other reference to support the rejection.

² For easy reference, claims 1 and 16 are set forth in Appendix One.

The “writing surface” recited in claims 1 and 16 cannot be considered obvious by the disclosure in Downing of a surface that is plainly not a writing surface. The claims do not recite *any surface* or *any surface with indicia*. The claims recite a “writing surface” *etc.* – which is not taught or suggested by Downing.

The obviousness rejection of these claims, citing no reference that teaches or suggests a writing surface, simply does not meet the fundamental requirement that the reference(s) teach or suggest all the elements of the claimed invention, and it should be reversed.

**II. THE “SEMI-RIGID CORE [WITH] A SLOT” AS RECITED IN
CLAIMS 34 AND 43 CANNOT BE OBVIOUS IN LIGHT OF THE
HOLLOW SPACE INSIDE A PLASTIC MEDALLION.**

Neither Weller nor Schmeida teach or suggest a semi-rigid core, as recited in independent claims 34 and 43³. Weller discloses a hollow, plastic medallion having no core element. (Weller, at col. 4, lines 16-24). Schmeida discloses an adhesive label, (col. 4, lines 62-65,) also having no core element.

The “core 10” in Weller is a hollow space – not a physical element. A hollow space cannot render obvious the “semi-rigid core” recited in claims 34 and 43. The Examiner’s assertion that “Weller teaches core 10” is misleading (at best) and should carry no weight. The disclosure of a hollow space cannot reasonably satisfy the

³ For easy reference, claims 34 and 43 are set forth in Appendix Two.

examiner's initial burden of setting forth a *prima facie* case of obviousness with respect to the "semi-rigid core" as recited in claims 34 and 43.

The obviousness rejection of these claims simply does not meet the fundamental requirement that the references teach or suggest all the elements of the claimed invention. Accordingly, the rejection should be reversed.

III. CONCLUSION

Because the references do not teach or suggest all the elements of the claimed invention, and because the rejection fails to state a *prima facie* case of obviousness, the rejection should be reversed, with instructions to allow all the pending claims in the application.

Respectfully submitted,



J. Scott Anderson
Applicant, *Pro Se*
(USPTO Registration No. 48,563)

J. SCOTT ANDERSON
1214 Hillwood Court SE
Atlanta, Georgia 30316-2660
Telephone (404) 245-5718

CERTIFICATE OF EXPRESS MAILING

Express Mail Label: EV915329804US

Date of Deposit: Tuesday, October 9, 2007

I hereby certify that this paper is being deposited with the United States Postal Service's "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above in an envelope addressed to Mail Stop Appeal Brief – Patents, Commissioner for Patents, Post Office box 1450, Alexandria, Virginia 22313-1450.



J. Scott Anderson

APPENDIX ONE

Independent Claims 1 and 16

1. A label assembly comprising:
 - a generally planar writing surface for receiving temporary and permanent indicia; and
 - a semi-rigid core supporting said writing surface, said core defining a slot positioned and sized to releasably receive an edge of a generally planar wall of an open container such that a majority of said writing surface extends beyond said edge when said edge is received within said slot, and wherein the orientation of said slot is generally parallel to said writing surface.
16. A method of releasably mounting an erasable label across an edge of a generally planar wall of an open container, said method comprising:
 - providing a generally planar writing surface to receive said label, said writing surface suitable for receiving temporary and permanent indicia;
 - mounting said writing surface to a semi-rigid core; and
 - forming a slot within said core, said slot positioned and sized to releasably receive said edge such that a majority of said writing surface extends beyond said edge when said edge is received within said slot, and wherein the orientation of said slot is generally parallel to said writing surface.

APPENDIX TWO

Independent Claims 34 and 43

34. A label assembly comprising:

a generally planar writing surface for receiving temporary and permanent indicia; and

a semi-rigid core supporting said writing surface, said core having a thickness and generally opposing top and bottom sides, said writing surface extending from near said top side to a lower boundary,

wherein said core defines a slot within said thickness, said slot extending upward from said bottom side to a depth terminating near said lower boundary of said writing surface such that a majority of said writing surface extends beyond and generally above said slot.

43. A method of assembling a label, comprising:

providing a generally planar writing surface suitable for receiving temporary and permanent indicia;

mounting said writing surface to a semi-rigid core, said core having a thickness and generally opposing top and bottom sides, such that said writing surface extends from near said top side to a lower boundary; and

forming a slot within said thickness, said slot extending upward from said bottom side to a depth terminating near said lower boundary of said writing surface such that a majority of said writing surface extends beyond and generally above said slot.